

Handwritten signature/initials



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/845,315	05/01/2001	Hirofumi Wada	33216M073	2240

7590 05/30/2006
SMITH, GAMBRELL & RUSSELL, LLP
1850 M Street, N.W., Suite 800
Washington, DC 20036

EXAMINER

CHEVALIER, ROBERT

ART UNIT	PAPER NUMBER
----------	--------------

2621

DATE MAILED: 05/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/845,315

Applicant(s)

WADA, HIROFUMI

Examiner

Bob Chevalier

Art Unit

2621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8 and 10 is/are rejected.
- 7) ☒ Claim(s) 6,7,9 and 11-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 May 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5 and 10, are rejected under 35 U.S.C. 103(a) as being unpatentable over the submitted prior art of Tokano et al (EP 0660485) in view of Official Notice.

Tokano et al discloses an image recording apparatus that shows substantially the same limitations recited in claims 1, 2, and 10, including the feature of the plurality of recording devices for recording image data in a prescribed recording medium, each of the recording device is arranged to record data from outside the data recording system as specified in the present claims (See Tokano et al's Figure 9, components 24a, and 24b), the feature of determining by a predetermined method, a specific one of the recording devices for recording the data among the plurality of recording devices (See Tokano et al's column 9, lines 29-31), the feature of the determination means automatically deciding which recording device should record among the plurality of recording devices by the predetermined method as specified in the present claims 1-2, and 10. (See Tokano et al's column 11, lines 32-42).

Tokano et al fails to specifically disclose the feature of playing back the recorded data to outside the data recording system as specified in the present claims 1-2, and 10.

Examiner takes Official Notice in that it is notoriously well known in the image/video recording/reproducing art to have a recording/reproducing means arranged

in a manner to play back recorded data from a recording medium to outside the recording system as recited in the present claims 1-2, and 10.

It would have been obvious to one skilled in the art to modify the Tokano et al's apparatus wherein the recording system provided thereof (See Tokano et al's Figure 9) would incorporate a reproducing means that is arranged in a manner to playback the recorded data from the recording medium to outside the recording system in the same conventional manner as is well known in the prior art. Examiner has taken Official Notice. The motivation is to be able to retrieve the recorded data at any desired time as suggested in the prior art.

With regard to claims 3, and 5, the feature of the predetermined method is to select any of the plurality of recording devices predetermined by the user as specified thereof would be inherently present in the cited reference of Tokano et al. Because conventional camera apparatus such as the one shown in Tokano et al would forcedly include the capability of allowing the user to choose the recording medium to perform the recording operation on. (See Tokano et al's column 8, line 1).

With regard to claim 4, the feature of the removable recording device specified thereof is present in Tokano et al. (See Tokano et al's Figure 9, components 24a, 24b).

3. Claim 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tokano et al and Official Notice as applied to claim 2 above, and further in view of Official Notice, when said claim 8 is depended upon any of claims 2-5.

The proposed combination of Tokano et al and Official Notice indicated above discloses an image recording/reproducing apparatus that shows substantially the same

limitations recited in claim 8, including the feature of the plurality of recording devices for recording image signal thereon as specified in the present claim 8. (See the above rejection of claim 2).

The proposed combination of Tokano et al and Official Notice indicated in the above rejection of claim 2 fails to specifically disclose the feature of stopping recording operation when the remaining recording capacity of the recording medium is equal or smaller than a predetermined capacity as specified in claim 8.

Examiner is taken Official Notice in that it is notoriously well known in the video recording/reproducing art to have a recording apparatus including the capability of stopping the recording operation on a recording medium when the remaining recording capacity of the recording medium is equal or smaller than a predetermined recording capacity as specified in claim 8.

It would have been obvious to one skilled in the art to modify the proposed combination of Tokano et al and Official Notice indicated in the above rejection of claim 2 wherein the recording means provided thereof (See Tokano et al's Figure 9) would incorporate the capability of stopping the recording operation on a recording medium when the remaining recording capacity of the recording medium is equal or smaller than a predetermined recording capacity in the same conventional manner as is well known in the video recording art. Examiner has taken Official Notice. The motivation is to make sure that the signal is completely recorded as desired and as suggested in the prior art.

4. Claims 6-7, 9, and 11-14, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bob Chevalier whose telephone number is 571-272-7374. The examiner can normally be reached on MM-F (9:00-6:30), second Monday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B. Chevalier

Application/Control Number: 09/845,315

Page 6

Art Unit: 2621

May 24, 2006.

Robert Chevalier
ROBERT CHEVALIER
PROPERTY EXAMINER